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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,725	01/17/2001	Richard L. Maliszewski	42390P6532C	8454

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EXAMINER

KISS, ERIC B

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,725

Applicant(s)

MALISZEWSKI, RICHARD L.

Examiner

Eric B. Kiss

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The reply filed March 8, 2004, has been received and entered. Claims 1-16 are pending.

Response to Arguments

2. Applicant's arguments filed March 8, 2004, have been fully considered but they are not persuasive.

As disclosed on p. 16, in line 6, through p. 17, line 23, an original executable program 16 is opened and modified by, among other operations, insertion of netsafe 1 and netsafe 2 code. An initial address of execution is changed to point to the newly added netsafe 1 code (p. 16, lines 33-35). Thereafter, when the modified program is executed, the netsafe 1 code is invoked (p. 17, lines 28-30). The netsafe 1 code performs test operations to ensure that security measures have been properly maintained (see, for example, steps (A2) and (A7) on pp. 17-18). Subsequently, the netsafe 2 code is invoked, which performs more test operations (see, for example, steps (B2), (B3), and (B4)). Thus, the flow of execution of the original program is modified to instead execute security testing routines contained within modules netsafe 1 and netsafe 2. Therefore, the Examiner maintains that *Drake* discloses transferring control to a test module.

3. In view of Applicant's unpersuasive arguments, the previous rejections are maintained and reproduced below.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 3-5, 7-9, and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by International Publication No. WO 97/04394 to Drake.

As per claims 1, 5, and 9, *Drake* discloses generating a software test module to produce a test result by performing a test on instructions (see, for example, page 14, line 34, through page 15, line 5; and page 16, line 6, through page 17, line 23); in the instructions, replacing a first instruction comprising a target address with a second non-identical instruction having an instruction address in the instructions, the second instruction to transfer control to the test module (see, for example, page 16, lines 20-32); and storing the target address encrypted in a table, the test module to locate the target address in the table and to set an execution address to the target address if the test result indicates the instructions are to proceed (see, for example, page 15, lines 8-11; and page 17, line 21, through page 18, line 27).

As per claims 3, 7, and 11, *Drake* further discloses corresponding the target address with the instruction address in the encrypted table (see, for example, page 18, line 28, through page 19, line 6).

As per claims 4, 8, and 12, *Drake* further discloses profiling the instructions to identify the first instruction as an instruction to replace (see, for example, page 16, lines 20-25).

As per claim 13, Drake discloses transferring control to a software test module when a second instruction having an instruction address in the instructions is executed by a data processing device, the second instruction replacing a non-identical first instruction comprising a target address (see, for example, page 16, lines 20-32);

a test module comprising a table comprising a target address of the replaced first instruction (see, for example, page 16, lines 26-32); and test instructions to produce a test result by performing a test on the instructions, the test module to locate the target address in the table and to transfer control to the target address if the test result indicates the instructions are to proceed (see, for example, page 18, line 28, through page 19, line 6).

As per claim 14, Drake further discloses loading the test module (see, for example, page 15, lines 8-11).

As per claim 15, Drake further discloses the test module comprising instructions to set an exception handler to transfer control to the test instructions when the second instruction is executed by the data processing device (see, for example, page 19, lines 14-18).

As per claim 16, Drake further discloses the test module comprising instructions moved from the instructions, the instructions moved to make room in the instructions for the instructions to load the test module (see, for example, page 16, lines 26-32).

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 2, 6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 97/04394 to Drake in view of U.S. Patent No. 5,966,541 to Agarwal.

As per claim 2, 6, and 10, Drake discloses such features (see the disclosure applied above to claims 1, 5, and 9) but fails to expressly disclose compacting the instructions to eliminate a hole created by replacing the first instruction with the second instruction. However, Agarwal teaches that it is known to shift a set of instructions in conjunction with the act of inserting or removing an instruction (see, for example, column 7, lines 20-26; note that replacing an instruction is the equivalent of inserting a new instruction and deleting an old instruction). Therefore, it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to modify the invention of Drake to include compacting instructions to eliminate a hole created by replacing an instruction. One would be motivated to do so to prevent invalid op codes, as an artifact of a replaced instruction, from remaining in a set of instructions.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The Examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBK / EBK
May 4, 2004



TUAN DAM
SUPERVISORY PATENT EXAMINER